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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GONZALEZ, MADELINE	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,713	SCHROEDER ET AL.	
	Examiner	Art Unit	
	Madeline Gonzalez	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/7/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26-30, 43 and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- an apparatus to facilitate identification of a bearing having a certain size comprising: a mold comprising a top surface, a bottom surface, and a form region, the top surface comprising a marking identifying a bearing model number, the form region comprising, a form bottom surface substantially parallel to the top surface, an outer wall contiguous with the top surface and the form bottom surface, the outer wall having a contoured surface and a generally cylindrical shape, the contoured surface designed to fit rollers of only the bearing having the certain size, and a hub disposed within the outer wall and between the top surface and the form bottom surface, the hub comprising a hub top surface substantially parallel to the top surface and an inner wall contiguous with the hub top surface and the form bottom surface and having a generally cylindrical shape;
- wherein the mold comprises a plastic material;
- wherein the mold further comprises a removable cover that attaches to the top surface of the mold;
- wherein a protective material is placed between the top surface of the mold and the removable cover;
- wherein the top surface further comprises a rim around the perimeter of the mold;

- wherein the outer wall and the hub are disposed to measure an outer diameter and an inner diameter of the bearing simultaneously; and
- wherein the contoured surface of the outer wall is shaped to prevent a bearing having a size different from the certain size from properly fitting in the form region.

3. Claims 31-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-11 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- a method for storing a bearing using a bearing mold to facilitate use of an appropriate-sized bearing comprising: placing the bearing in the bearing mold, wherein the bearing mold is designed with a recess comprising an inner hub and an outer contoured surface such that only one size of bearing properly fits in the bearing mold; and verifying that the appropriate-sized bearing is placed in the bearing mold by checking that a bearing serial number and a device model identifier on the bearing mold correspond to the bearing;
- shipping the packaged bearing from a manufacturer of the bearing to a purchaser;
- storing the packaged bearing for later installation in the device; and
- storing the packaged bearing in a rack comprising packaged bearings of the same size.

4. Claims 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 14 and 16 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- a method for installing an appropriate-size bearing in a device using a bearing mold, comprising the steps of: selecting a rack holding the bearing mold containing the appropriate-size bearings for the device; removing the bearing mold from the rack, wherein the bearing mold is designed with a recess comprising an inner hub and a contoured outer surface shaped to receive only the appropriate-size of bearing; verifying a device model number and a bearing model number on the bearing mold; removing the bearing from the bearing mold; and installing the bearing in the device;
- wherein the rack holds bearing molds containing bearings of the same size; and
- wherein the step of removing the bearing further comprises using notches in the bearing mold.

5. Claims 38, 39, 45 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-21 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- an apparatus to facilitate identification of a bearing having a certain size comprising: a mold, comprising a top surface, a bottom surface, and a form region, wherein the

dimensions of the form region are such that only the bearing having the certain size can correctly fit in the form region, the form region comprising, a form bottom surface substantially parallel to the top surface, an outer wall contiguous with the top surface and the form bottom surface, the outer wall having a contoured surface and a generally cylindrical shape, the contoured surface designed to fit rollers of only the bearing having the certain size, a step disposed between the top surface and the form bottom surface and further disposed outside the outer wall, the step operable for facilitating placement and removal of the bearing in the form region, the step comprising a step surface generally parallel to the top surface and contiguous with the outer wall and a step wall generally parallel to the outer wall and contiguous with the step surface and the top surface; and a hub disposed within the outer wall and between the top surface and the form bottom surface, the hub comprising a hub top surface substantially parallel to the top surface and an inner wall contiguous with the hub top surface and the form bottom surface and having a generally cylindrical shape; and

- wherein the hub top surface is level with a bearing top surface when the bearing having the certain size is placed in the form region;
- wherein the outer wall and the hub are disposed to measure an outer diameter and an inner diameter of the bearing simultaneously; and
- wherein the contoured surface of the outer wall is shaped to prevent a bearing having a size different from the certain size from properly fitting in the form region.

6. Claims 40-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- an apparatus to facilitate identification of a bearing having a certain size comprising: a mold sized to accept the bearing having the certain size, the mold comprising a top surface, a bottom surface, and a form region, the form region comprising, a form bottom surface substantially parallel to the top surface, an outer wall contiguous with the top surface and the form bottom surface, the outer wall having a contoured surface desired to receive the rollers of only the bearing having the certain size and a generally cylindrical shape, the outer wall comprising a first notch and a second notch operable for facilitating removal of the bearing from the form region, and a hub disposed within the outer wall and between the top surface and the form bottom surface, the hub comprising a hub top surface substantially parallel to the top surface and an inner wall contiguous with the hub top surface and the form bottom surface and having a generally cylindrical shape;
- wherein the inner wall comprises a third notch and a forth notch operable for facilitating removal of the bearing from the form region; and
- wherein the first notch, the second notch, the third notch, and the fourth notch are contiguous with the form bottom surface so as to reduce the existence of a vacuum between the surfaces of the bearing and the mold.

7. Claims 47-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-29 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- an apparatus to facilitate identification of a bearing having a certain size comprising: a mold comprising a top surface, a bottom surface, a step, and a form region, the form region comprising, a form bottom surface substantially parallel to the top surface, an outer wall contiguous with the form bottom surface, the outer wall having a generally cylindrical shape and a contoured surface shaped to receive only the bearing having the certain size, and a hub disposed within the outer wall and between the top surface and the form bottom surface, the hub comprising, a hub top surface substantially parallel to the top surface and an inner wall contiguous with the hub top surface and the form bottom surface and having a generally cylindrical shape, and the step disposed between the top surface and the form bottom surface and further disposed outside the outer wall, wherein the step facilitates placement and removal of the bearing in the form region;
- wherein the step comprises: a step surface generally parallel to the top surface and contiguous with the outer wall and a step wall generally parallel to the outer wall and contiguous with the step surface and the top surface;
- wherein the contoured surface of the outer wall comprises a series of recesses;
- wherein the outer wall comprises a first notch and a second notch operable for facilitating removal of the bearing from the form region; and

- wherein the outer wall and the hub are disposed to measure an outer diameter and an inner diameter of the bearing simultaneously.

8. Claims 52-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-34 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- an apparatus to facilitate identification of a bearing having a certain size comprising: a mold comprising a top surface, a bottom surface, and a form region, the form region comprising, a form bottom surface substantially parallel to the top surface, an outer wall contiguous with the top surface and the form bottom surface, the outer wall having a generally cylindrical shape, comprising a first notch contiguous with the form bottom surface and a second notch contiguous with the form bottom surface, and further comprising a contoured surface designed to receive the rollers of only the bearing having the certain size, and a hub disposed within the outer wall and between the top surface and the form bottom surface, the hub comprising, a hub top surface substantially parallel to the top surface and an inner wall contiguous with the hub top surface and the form bottom surface and having a generally cylindrical shape;
- wherein the inner wall comprises a third notch and a fourth notch for facilitating removal of the bearing from the form region;

- wherein the third notch is contiguous with the form bottom surface and the fourth notch is contiguous with the form bottom surface;
- wherein the outer wall and the hub are disposed to measure an outer diameter and an inner diameter of the bearing simultaneously; and
- a step disposed between the top surface and the form bottom surface and further disposed outside the outer wall, wherein the step facilitates placement and removal of the bearing in the form region.

9. Claim 57 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,688,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,688,015 discloses:

- a method for storing a bearing using a bearing mold to facilitate use of an appropriate-sized bearing comprising: placing the bearing in the bearing mold, wherein the bearing mold comprises an inner hub and a contoured outer wall that allow only the appropriate-sized bearing to properly fit in the bearing mold; verifying that the appropriate-sized bearing is placed in the bearing mold by determining whether the bearing properly fits in the bearing mold; and removing the bearing from the bearing mold, wherein a step feature in the bearing mold facilitates removing the bearing.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG

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